

REMARKS

Please reconsider the application in view of the following remarks. Applicant thanks the Examiner for carefully considering this application.

Disposition of Claims

Claims 1-21 were pending in this application. Claims 5 and 9-10 have been cancelled without prejudice or disclaimer by way of this submission. New claims 22-25 have been added by way of this submission. Accordingly, claims 1-4, 6-8, and 11-25 are currently pending in this application. Claim 1 is independent. The remaining claims depend, directly or indirectly, from independent claim 1.

Claim Amendments

As discussed, claims 5 and 9-10 have been cancelled without prejudice or disclaimer by way of this submission. Further, claims 1-4, 6-8, and 11-21 have been amended by way of this submission. Support for the aforementioned claim amendments may be found in, for example, paragraphs [0020]-[0021] and FIG. 1 of the originally-filed specification. Applicant respectfully asserts that no new matter has been added by way of these amendments.

Rejections under 35 U.S.C. § 102

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical

invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claims 1-21 stand rejected under 35 U.S.C. § 102(e) as being anticipated by WIPO Patent Publication No. 2004/019261 ("Nishikawa"). As discussed, claims 5 and 9-10 have been cancelled. Accordingly, this rejection is moot with respect to the aforementioned cancelled claims and, as such, withdrawal is respectfully requested with respect to the cancelled claims. To the extent this rejection applies to the currently pending claims, the rejection is respectfully traversed.

- I. The prior art's SIM card antenna relied upon by the Examiner's rejection is not equivalent to the antenna recited by the currently pending claims

The Examiner's rejection relies upon Nishikawa's discussion of a "mobile telephone" to generally disclose a portable communication device in communication with a terminal (*i.e.*, as recited by the pending claims). *See* pages 2-3 of the OA. Nishikawa's mobile telephone is configured to receive a SIM card. *See, e.g.*, Nishikawa: page 23 lines 17-18 and 32-33. In making the rejection, the Examiner equates Nishikawa's SIM card with the micro-module recited by independent claim 1. *See, e.g.*, page 2 item #4 of the OA, lines 8-11 (citing, in relation to the micro-module, Nishikawa's page 23 lines 32-33: "The SIM of the present invention can be used on a portable telephone.")). Further, the Examiner's rejection specifically equates an antenna coil embedded in Nishikawa's SIM card with the antenna recited by independent claim 1. *See, e.g.*, pages 2-3 of the OA (The Examiner states "The micro-module 2 is illustrated in figure 1 [of Nishikawa] and includes a chip 3 and an *antenna* 21, which allows the micro-module to communicate with the terminal when the antenna is placed in a vicinity of the terminal.")).

Amended independent claim 1 recites, in part, “a portable communication device for at least mono-directional communication with a terminal, comprising: a micro-module comprising a chip; and a reader configured to receive the micro-module, wherein the reader comprises an antenna of low or medium range type allowing the micro-module to transmit a radio-frequency (RF) communication to the terminal when the antenna is placed in a vicinity of the terminal ...” (Emphasis added) As such, amended independent claim 1 requires, in part, a portable communication device with two separate components: a reader and a micro-module. Further, amended independent claim 1 requires that the reader component includes an antenna of low or medium range type.

With respect to amended independent claim 1, the Examiner’s rejection is respectfully traversed. As the Examiner’s rejection contends, Nishikawa does disclose an antenna coil embedded in a SIM card. However, because the Examiner’s rejection equates Nishikawa’s SIM card with a micro-module, Applicant respectfully asserts that Nishikawa’s antenna coil is at best a part of a micro-module and therefore not part of a reader. Because amended independent claim 1 requires that the recited antenna is part of a reader and therefore not part of a micro-module, Nishikawa’s SIM antenna may not be properly equated with the recited antenna of amended independent claim 1.

II. The Examiner’s rejection mischaracterizes the cited prior art

As discussed above, because the antenna coil is merely part of a SIM card and therefore not part of a reader as required by amended independent claim 1, the basis for the Examiner’s rejection is improper in view of the currently pending claims. Further, even assuming *arguendo* that the Examiner were to construe the antenna coil as part of a reader, Applicant respectfully asserts that

the antenna coil of Nishikawa would not be equivalent to the claimed antenna. Specifically, the Examiner's rejection relies upon Nishikawa's discussion of a "mobile telephone" to disclose each and every element of the previously pending claims. *See* pages 2-3 of the OA. Further, the Examiner's rejection implies that Nishikawa's SIM card antenna is operatively in communication with an external agent such as a terminal. *See, e.g.*, page 2 item #4 of the OA (citing Nishikawa pages 1-4 and 15-16: "... it is discussed ... how the SIM, which is held by a portable or mobile telephone, communicates either via contact or non-contact with various terminals such as credit card terminals, fuel pump terminals, etc."). Applicant respectfully disagrees.

Rather, Applicant respectfully asserts that Nishikawa does not contemplate use of the SIM card antenna when discussing scenarios involving a mobile telephone. Instead, the SIM card's use with Nishikawa's mobile telephone is such that "*the SIM communicates with the portable telephone through contact terminals*. The SIM mounted on a portable telephone is *unable* to use an infrastructure for noncontact IC cards." *See, e.g.*, Nishikawa: page 23 line 32 – page 24 line 6. From this, Applicant asserts the.

First, Nishikawa states that the SIM card, when mounted on a mobile telephone, communicates using contact terminals. Applicant respectfully asserts that a contact terminal is merely a physical point of contact between the SIM card and Nishikawa's mobile telephone. *See, e.g.*, Nishikawa: page 4 lines 2-9 and page 16 lines 11-18 in reference to Nishikawa's Figs. 1-5 (which show that a contact terminal is a physical feature located on Nishikawa's SIM card). Said another way, when mounted in a mobile telephone, the Nishikawa SIM card's mode of communication is at best a physical contact-based mode that does not make use of the SIM card's antenna.

Second, Nishikawa states that the SIM card, when mounted on a mobile telephone, operates in a state where the non-contact infrastructure is essentially disabled. Applicant respectfully asserts that an antenna is essentially a non-contact means of communication. As such, the SIM card's antenna is arguably part of the SIM card's non-contact infrastructure and therefore disabled when the SIM card is used with a mobile telephone. In view of the arguments presented above, Applicant respectfully asserts that the Examiner's basis for the rejection is improper. Specifically, the Examiner has mischaracterized the mobile telephone use case of Nishikawa as functioning in a manner (*e.g.*, with respect to the SIM card's antenna) that is contrary to what is discussed in Nishikawa's specification.

Because the antenna of Nishikawa's SIM card is effectively disabled and therefore inoperational when inserted into a mobile telephone, the SIM card is incapable of transmitting a RF signal to a terminal as required by amended independent claim 1. As such, Nishikawa's use case involving the SIM card and mobile telephone may not be properly construed to disclose each and every limitation of amended independent claim 1.

III. Summary

In view of the arguments presented above, Nishikawa fails to disclose every element of recited amended independent claim 1 and therefore amended independent claim 1 is patentable over Nishikawa. Further, dependent claims are patentable over Nishikawa for at least the same reasons provided in relation to amended independent claim 1. Accordingly, withdrawal of the rejection is respectfully requested.

New Claims

New claims 22-25 have been added by way of this submission. New claims 22-24 depend from amended independent claim 1. New claim 25 depends directly from new claim 24 and therefore indirectly depends from amended independent claim 1. Support for the aforementioned new claims may be found in, for example, paragraphs [0030], [0038], [0041], [0047]-[0048], [0074], and [0078] of the originally-filed specification. Applicant respectfully asserts that no new matter has been added by way of the aforementioned new claims.

New claims 22-25 are patentable over Nishikawa for at least the same reasons discussed in relation to amended independent claim 1. Applicant now provides additional arguments in support of the aforementioned new claims.

Regarding new claim 22, Applicant respectfully asserts that Nishikawa is silent with respect to any discussion of Near Field Communication (NFC). Paragraph [0038] of the originally-filed specification states that NFC is a specific protocol. Because Nishikawa is silent as to any device use that is compliant with the NFC protocol, Applicant respectfully asserts that Nishikawa may not be properly construed to disclose all the limitations of new claim 22.

Regarding new claim 23, Applicant respectfully asserts that Nishikawa is silent with respect to a display driver that is stored and executed on a chip. Rather, Nishikawa does not include any discussion of a display driver. As such, Nishikawa may at best be construed to disclose means for controlling a display that are native to the device receiving the chip/micro-module (*i.e.*, Nishikawa's mobile telephone which receives a SIM card). Said another way, because Nishikawa is silent with regards to an on-chip display driver, the display elements of Nishikawa's device (*e.g.*, mobile telephone) are presumed to be controlled by a module native to the device as opposed to any

external component such as a SIM card. For at least these reasons, Applicant respectfully asserts that Nishikawa may not be properly construed to disclose all the limitations of new claim 23.

Regarding new claim 24, Applicant respectfully asserts that Nishikawa is silent with respect to a memory component of the portable communication device that is configured to store encrypted private data. Rather, Nishikawa at best discloses that the SIM card itself (*i.e.*, not a device that receives the SIM card) stores secure user data. *See, e.g.*, Nishikawa: page 2 lines 11-25. Moreover, assuming *arguendo* that Nishikawa's device is construed to include a memory component for storing encrypted private data, Applicant further asserts that Nishikawa does not disclose the further limitation that encrypted private data (*i.e.*, stored in a portable communication device's memory component) is decrypted by a chip using a secret stored on the chip. For at least these reasons, Applicant respectfully asserts that Nishikawa may not be properly construed to disclose all the limitations of new claim 24. It further follows that Nishikawa may likewise not be properly construed to disclose all the limitations of new claim 25 (*i.e.*, which depends directly from new claim 24).

In view of the arguments presented above with respect to amended independent claim 1 and the aforementioned new claims, Applicant respectfully requests favorable action in the form of a Notice of Allowability.

Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 09669/094001).

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Respectfully submitted,

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